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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,010	07/12/2006	Glenn Viaplana Gordon	DCI0008 PCT 1	1380
137 7590 12/12/2008 DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994				
EXAMINER SCOTT, ANGELA C				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
12/12/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

# Office Action Summary

**Application No.**

10/586,010

**Applicant(s)**

GORDON ET AL.

**Examiner**

Angela C. Scott

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Applicant's response of August 27, 2008 has been fully considered. Claims 1-4 are pending.

#### *Claim Rejections - 35 USC § 103*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanji et al. (US 2002/0114773).

Regarding claim 1, Kanji et al. teaches a composition containing at least one film forming silicone resin chosen from siloxysilicates (MQ resins) and silsesquioxanes (¶54). Kanji et al. states that as used in the specification, the expression "at least one" means one or more and thus includes individual components as well as mixtures and combinations (¶1). By this definition, Kanji et al. teaches that the silicone resin of the composition could be comprised of two resins, a siloxysilicate and a silsesquioxane.

Siloxysilicates (the MQ resin) used in the composition are exemplified by trimethylsiloxysilicates, which are represented by the following formula:  $[(CH_3)_3Si-O]_x-(SiO_{4/2})_y$  (MQ units) where x and y can have values ranging from 50 to 80 (¶64). A siloxysilicate may also be chosen from any combination of M and Q units, such as, for example,  $[(R)_3Si-O]_x-(SiO_{4/2})_y$ , where R is chosen from a methyl group and longer carbon chains (¶64). The entire resin can be made of MQ units giving at least 80 mole % of them.

Silsesquioxanes used in the composition are represented by the following formula:  $(CH_3SiO_{3/2})_x$  where x has a value of up to several thousand and the  $CH_3$  may be replaced (¶65) by a longer carbon chain such as an ethane, propane, or butane (¶63), therefore teaching the claimed propyl Silsesquioxane resin. All of the  $CH_3$  groups could be replaced with propane giving at least 40 mole % of the substituted groups being propyl. Additionally, the entire resin can be made of  $(CH_3SiO_{3/2})_x$  units giving at least 80 mole % of them.

Kanji et al. additionally teaches the presence of volatile siloxanes in the composition (¶96).

Kanji et al. does not teach that the weight ratio of two resins in a mixture is from 1:99 to 99:1. However, at the time of the invention, a person of ordinary skill in the art would have mixed the resins within this ratio because this ratio simply teaches the presence of two resins in the composition.

Kanji et al. does not teach the specific combination of the above resins in the resin composition. However, at the time of the invention, a person of ordinary skill in the art would have been motivated to pick these two types of film-forming resins and combine them as part of a composition because they each bring different properties to the composition (i.e., the MQ resins are typically harder while the silsesquioxanes are generally continuous and flexible) and combining them can help maximize transfer resistant properties as well as pliability, softness and wearing comfort of the composition.

Regarding claims 2-4, Kanji et al. additionally teaches personal care products such as cosmetics and hair care products (¶12).

### ***Response to Arguments***

Applicant's arguments filed August 27, 2008 have been fully considered but they are not persuasive.

Applicant's argue that while Kanji et al. does teach that the methyl group in the silsesquioxane resin may be replaced by R which is a longer carbon chain such as an ethane, propane, or butane, there are no examples provided where R is propyl. Applicant is reminded that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). In this case, Kanji et al. teaches not only methyl silsesquioxane resins, but also ethyl, propyl and butyl silsesquioxane resins.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela C. Scott whose telephone number is (571) 270-3303. The examiner can normally be reached on Monday through Friday, 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/  
Supervisory Patent Examiner, Art Unit 1796

/A. C. S./  
Examiner, Art Unit 1796